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Paper No. 11
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Southwest Bank of Texas, N.A.

Serial No. 75/538,082

Jack R. Bailey for Southwest Bank of Texas, N.A.

Alicia Benmaman, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Cissel, Seeherman and Quinn, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 17, 1998, applicant applied to register the
mark "BILL P@Y" on the Principal Register for "providing
banking and financial services," in Class 36.¹ The

¹ Although the specimens present the mark in lower case lettering, the drawing submitted with the application, as well as the heading of the application itself, depict the mark as "BILL P@Y." Notwithstanding contrary indications in the text of the application and in applicant's arguments throughout the prosecution of this application, the drawing is determinative of the mark applicant is seeking to register, and it is the mark shown in the drawing, "BILL P@Y," which we have considered in connection with the refusal to register under Section 2(d). We hasten to add that if applicant had amended the application to seek registration of the mark "bill p@y" in special form, our

application is based on applicant's claim of use of the mark in connection with rendering the services in interstate commerce since May 4, 1998.

The Examining Attorney refused registration under Section 2(d) of the Lanham Act on the ground that applicant's mark, as used in connection with the services set forth in the application, so resembles the mark "USAA BILLPAY," which is registered² for "financial services, namely payment of third[-]party bills on telephone authorization of account holder," in Class 36, that confusion is likely. In addition to the refusal to register, the Examining Attorney required applicant to amend the recitation of services to be more definite.

Responsive to the first Office Action, applicant presented arguments on the issue of likelihood of confusion and amended the recitation of services to read as follows: "banking and financial services, namely payment of third[-]party bills and otherwise dealing with third[-]party payees electronically via PC or telephone." Submitted in support of applicant's position that confusion is not likely were a copy of dictionary pronunciation guidelines and

decision regarding the issue of likelihood of confusion would have been the same.

² Reg. No. 1,951,916, issued on the Principal Register to United Services Automobile Association on Jan. 23, 1996.

dictionary entries for the words "bill" and "pay." This evidence also shows that no listing appears for the term "billpay" as one word. Applicant contended that this evidence establishes that the marks differ in pronunciation and meaning, and that confusion is therefore not likely.

The Examining Attorney was not persuaded by applicant's evidence or arguments, and in the second Office Action, she made the refusal to register under Section 2(d) final based on her conclusion that the mark applicant seeks to register is similar to the cited registered mark and the services of registrant and applicant are the same.

In addition to making the refusal to register final, in her second Office Action, the Examining Attorney held the amended recitation of services to be unacceptably indefinite, and required applicant to amend the recitation to eliminate the wording "otherwise dealing with third[-]party payee electronically via PC or telephone." The requirement for an acceptable recitation of services was continued and made final.

Applicant timely filed a Notice of Appeal, along with

an appeal brief. The Examining Attorney filed her brief on appeal and applicant filed a reply brief³, but applicant did not request an oral hearing before the Board.

Although in the second Office Action, the Examining Attorney made final the requirement for applicant to amend the recitation of services to eliminate indefinite terminology, applicant did not do so, nor did applicant present arguments on this issue in its brief. The Examining Attorney, in recounting the procedural history of this application in her brief, noted that the requirement for an amended recitation of services had been made final, but thereafter failed even to mention this issue, much less to present argument or evidentiary support for sustaining this requirement. Under the circumstances, in view of the fact that the Examining Attorney has the burden of proof with respect to the propriety of a final requirement, we

³ The additional evidence submitted with applicant's reply brief has not been considered. The record closed with the filing of the Notice of Appeal. Trademark Rule 2.142(d). Contrary to applicant's arguments, the Board may not take judicial notice of Office records of third-party registrations. Moreover, even if the record contained properly introduced copies of the third-party applications and registrations applicant did not timely submit, such records would not be evidence of use of the marks therein. Thus they could not be the basis for the Board to reach the conclusion that the terms "bill" and "pay" are so frequently used in connection with services of the type involved in the instant case that consumers of these services are readily able to distinguish among marks which include the two words based on other small distinctions in such marks.

deem this issue to have been conceded by the Examining Attorney through her inaction. The requirement for amendment to the recitation of services is therefore reversed.

We turn, then, to the question of whether applicant's mark, "BILL P@Y," in connection with the services set forth in the application, as amended, namely "banking and financial services, namely payment of third[-]party bills and otherwise dealing with third[-]party payees electronically via PC or telephone," is likely to cause confusion with the mark "USAA BILLPAY," as used in connection with the services specified in the registration, "financial services, namely payment of third[-]party bills on telephone authorization of account holder." Based on careful consideration of the record before us in this appeal and the relevant legal authority, we hold that the refusal to register under Section 2(d) is not well taken.

The predecessor to our primary reviewing court listed the principal factors to be considered in determining whether confusion is likely in the case of *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the services.

In the case before us, although the services set forth in the application appear to be the same or very closely related to those specified in the cited registration, confusion is not likely because the mark applicant seeks to register creates a different commercial impression from that which is engendered by the cited registered mark.

We have not been persuaded to reach this conclusion by any of applicant's overly technical arguments, such as those based on the numbers of letters and syllables in the marks, or on the fact that neither "USAA" nor "BILLPAY" are words that are listed in a dictionary. The plain fact is that the words "bill" and "pay," in the context of either applicant's mark or the cited registered mark, would be understood in connection with the respective services of applicant and registrant as conveying the fact that the services involve bill payment. In these contexts, both marks are suggestive of the services in connection with which they are used because both services involve the payment of bills. The only similarity between these two marks is that both contain these highly suggestive words. It is well settled, however, that use of such suggestive terminology does not entitle the prior user to a broad scope of protection.

The commercial impressions these two marks generate are sufficiently different to permit customers of these services to distinguish between the marks. This difference is the result of the use of the letters "USAA" in registrant's mark and applicant's use of the distinctive "@" sign in place of the letter "a" in the word "pay." The registered mark uses the composite term "BILLPAY," which would be quite similar to the mark "BILL PAY," but, as noted above, "BILL PAY" is not applicant's mark, "BILL P@Y" is. In addition, the registered mark combines "BILL PAY" with the apparently arbitrary, at least in connection with these services, letters "USAA." The unusual spelling, or stylized presentation, of the word "pay" in applicant's mark, combined with the additional arbitrary letters in the cited registered mark, are sufficient differences to allow prospective customers to distinguish between the two suggestive marks. Because of these distinctions, even though the services are essentially the same, confusion is not likely.

Decision: The requirement for amendment to the recitation of services and the refusal to register applicant's mark under Section 2(d) of the Lanham Act are both reversed.

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